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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,885	07/23/2001	Hiroshi Sato	MA-496-US	2326

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EXAMINER

SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/15/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/909,885

Applicant(s)

SATO ET AL.

Examiner

Cristina O Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the Application filed 23 July 2001. Claims 1-28 have been examined in this case.

#### ***Specification***

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

5. Regarding claim 1 –

Downs discloses a content delivering method for providing information to a customer through the Internet, wherein a content rental dealer provides a customer with a secret key valid only during a rental period and encrypted content data, in rental of content data, and a customer reproduces the content data with the secret key (col 3 ln 40-55).

6. Regarding claim 2-

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Downs discloses a content delivering method as claimed in Claim 1, comprising the steps of: creating a secret key valid only during a rental period, based on received order information about rental of content data, specifying the content data to be delivered based on the order information, encrypting the specified content data to be delivered, and sending the secret key and the encrypted content data to a delivery destination terminal (col 5 ln 36-64).

7. Regarding claim 3 –

Downs discloses a content delivering method as claimed in Claim 1, wherein a content rental dealer induces a customer to select a payment method of a rental charge, hence to settle up the rental charge according to the payment method selected by the customer (col 11 ln 15-28).

8. Regarding claim 4 –

Downs discloses a content delivering method as claimed in Claim 1, wherein a content rental dealer checks customer's credit authorization through access to a credit authorization network built by financial institutions , in settlement of a rental charge (col 11 ln 15-28).

9. Regarding claim 5 –

Downs discloses a content delivering method as claimed in Claim 1, wherein a content rental dealer induces a customer to select a payment method of a rental charge, hence to settle up the rental charge according to the payment method selected by the customer, and a content rental dealer checks customer's credit authorization through

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access to a credit authorization network built by financial institutions, in settlement of a rental charge (col 10 ln 50-67).

10. Regarding claim 6 –

Downs discloses a content delivering method as claimed in Claim 3, wherein payment is performed by a credit card, a tie-up card of financial institutions, electronic money, or payment confirmation into a specified account of a financial institution (col 11 ln 15-28).

11. Regarding claim 7 –

Downs discloses a content delivering method as claimed in Claim 1, wherein a content rental dealer presents advertisement information to a customer (col 9 ln 62 – col 10 ln 3).

12. Regarding claim 8 –

Downs discloses a content delivering method as claimed in Claim 1, wherein a content rental dealer selects the advertisement information to each customer's taste, based on accumulated customer information, hence to send the same information to each customer via electronic mail (col 9 ln 62 – col 10 ln 3).

13. Regarding claim 9 –

Downs discloses a content delivering method as claimed in Claim 1, wherein a content rental dealer creates customer's taste data by classifying the accumulated customer information into predetermined items (col 43 ln 58-col 54 ln 4).

14. Regarding claim 10 –

Downs discloses a content delivering method as claimed in Claim 9, wherein

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a content rental dealer collects an information supply charge by supplying the customer's taste data to another (col 43 ln 58-col 54 ln 4).

15. Claims 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

16. Regarding claim 11 –

Downs discloses a content delivering system for delivering information to a delivery destination terminal through the Internet, comprising: a server for receiving order information relative to rental of content data from a customer terminal, creating a secret key valid only during a rental period based on the order information, and delivering the secret key to the delivery destination terminal specified by a customer, and a content store server for storing a plurality of content data, encrypting the content data to be delivered and delivering the same data to the delivery destination terminal according to an instruction from said server (col 3 ln 40-55).

17. Regarding claim 12 –

Downs discloses a content delivering system as claimed in Claim 11, wherein the order information includes item number of content data, its rental period, and address of the delivery destination terminal, and delivery start time and date or secret key delivery time and date of the content data (col 9 ln 62 – col 10 ln 3).

18. Regarding claim 13 –

Downs discloses a content delivering system as claimed in Claim 11, wherein said server delivers advertisement data to the delivery destination terminal (col 9 ln 62 – col 10 ln 3).

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19. Regarding claim 14 –

Downs discloses a content delivering system as claimed in Claim 11, wherein said content store server delivers advertisement data, which is attached to the content data, to the delivery destination terminal (col 10 ln 1-5).

20. Regarding claim 15 –

Downs discloses a content delivering system as claimed in Claim 11, wherein said server notifies the item number of the content data and the address of the delivery destination terminal to said content store server, in a delivery instruction of the content data (col 9 ln 62 – col 10 ln 3).

21. Regarding claim 16 –

Downs discloses a content delivering system as claimed in Claim 11, wherein said server creates customer identification information indicating a correspondence between a customer and order content, from the order information, classifies the customer identification information into predetermined items, and stores the same information (col 43 ln 58-col 54 ln 4).

22. Claims 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

23. Regarding claim 17 –

Downs discloses a content delivering server for delivering information to a delivery destination terminal through the Internet, comprising: a first server for receiving order information relative to rental of content data from a customer terminal, creating a secret key valid only during a rental period based on the order information, and delivering the

secrete key to the delivery destination terminal specified by a customer, and a second server for storing a plurality of content data, encrypting the content data to be delivered and delivering the same data to the delivery destination terminal according to an instruction from said server (col 3 ln 40-55).

24. Regarding claim 18 –

Downs discloses a content delivering server as claimed in Claim 17, wherein the order information includes item number of content data, its rental period, and address of the delivery destination terminal, and delivery start time and date or secret key delivery time and date of the content data (col 9 ln 62 – col 10 ln 3).

25. Regarding claim 19 –

Downs discloses a content delivering server as claimed in Claim 17, wherein said first server delivers advertisement data to the delivery destination terminal (col 9 ln 62 – col 10 ln 3).

26. Regarding claim 20 –

Downs discloses a content delivering server as claimed in Claim 17, wherein said second server delivers advertisement data, which is attached to the content data, to the delivery destination terminal (col 10 ln 1-5).

27. Regarding claim 21 –

Downs discloses a content delivering server as claimed in claim 17, wherein said first server notifies the item number of the content data and the address of the delivery destination terminal to said second server, in a delivery instruction of the content data (col 9 ln 62 – col 10 ln 3).



28. Regarding claim 22 –

Downs discloses a content delivering server as claimed in Claim 17, wherein said first server creates customer identification information indicating a correspondence between a customer and order content, from the order information, classifies the customer identification information into predetermined items, and stores the same information (col 43 ln 58-col 54 ln 4).

29. Claims 23-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

30. Regarding claim 23 –

Downs discloses a content delivering program for delivering information to a destination terminal through the Internet, comprising the functions of: creating a secret key valid only during a rental period, based on received order information about rental of content data, specifying the content data to be delivered based on the order information, encrypting the specified content data to be delivered, and sending the secret key and the encrypted content data to the delivery destination terminal (col 3 ln 40-55).

31. Regarding claim 24 –

Downs discloses a content delivering program as claimed in Claim 23, wherein the order information includes item number of content data, its rental period, and address of the delivery destination terminal, and delivery start time and date or secret key delivery time and date of the content data (col 9 ln 62 – col 10 ln 3).

32. Regarding claim 25 –

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Downs discloses a content delivering program as claimed in Claim 23, comprising a function of: delivering advertisement data to the delivery destination terminal (col 9 ln 62 – col 10 ln 3).

33. Regarding claim 26 –

Downs discloses a content delivering program as claimed in Claim 23, comprising a function of: delivering advertisement data, which is attached to the content data, to the delivery destination terminal (col 10 ln 1-5).

34. Regarding claim 27 –

Downs discloses a content delivering program as claimed in Claim 23, comprising a function of: notifying the item number of the content data and the address of the delivery destination terminal to a server which stores content, in a delivery instruction of the content data (col 9 ln 62 – col 10 ln 3).

35. Regarding claim 28 –

Downs discloses a content delivery system as claims in claim 23, comprising a function of: creating customer identification information indicating a correspondence between a customer and order content, from the order information, classifying the customer identification information into predetermined items, and storing the same information (col 43 ln 58-col 44 ln 4).

36. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures

may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

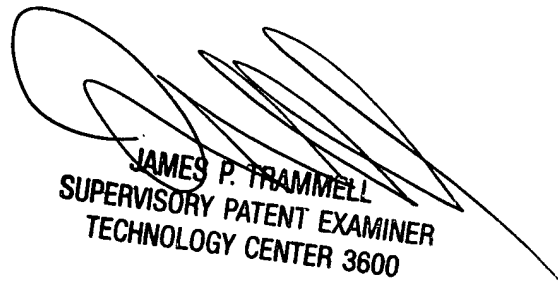
***Conclusion***

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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